

OHNISHI**Application No. 09/809,095****Response to Office Action dated June 17, 2004****Remarks**

Reconsideration and allowance of the subject patent application are respectfully requested.

Applicant's representative wishes to thank Examiners Arshad and Kincaid for the courtesy extended during the interview of August 31, 2004. The substance of the interview is set forth in the discussion below.

Claims 5 and 12 were rejected under 35 U.S.C. Section 112, second paragraph, as allegedly being indefinite. Claims 5 and 12 have been amended to delete the term "proximity". Consequently, withdrawal of the Section 112, second paragraph, rejection of these claims is respectfully requested.

Claims 1, 3, 4 and 12 were rejected under 35 U.S.C. Section 102(e) as allegedly being "anticipated" by Morris *et al.* (U.S. Patent No. 6,097,389). Morris *et al.* discloses creating photo albums from various digital images. With reference to Figure 12B, the office action apparently contends that the images on the album page 807 are the claimed "reduced-size" images and that the thumbnails in the separate thumbnail region 809 are the claimed "file icons." In one described implementation, the assigned order of pictures in an album may be changed by dragging and dropping one of the "thumbnails" from a current position in the thumbnail region to another position in the thumbnail region. The picture album will then automatically and dynamically reposition the pictures in the album pages based on the changes made in the thumbnail region. *See, e.g.*, col. 13, lines 36-61. The office action alleges that claim 1 is anticipated by Morris *et al.*

As discussed at the interview, claim 1 has been amended to describe (1) that the reduced-size image and file icon are concurrently displayed and (2) that the display position of the file icon relative to the display position of the reduced-size image is predetermined to be the same for each reduced-size image/file icon pair. As further discussed at the interview, even assuming that the images on album page 807 of Morris *et al.* are alleged to be the claimed "reduced-size images" and that the thumbnails in the separate thumbnail region 809 are alleged to be the claimed "file icons", there is no teaching or suggestion that the display positions of the thumbnails relative to the display positions of the images be the same for each thumbnail/image

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pair. Consequently, *Morris et al.* cannot anticipate the subject matter of claim 1 or of claims 3, 4 and 12 which depend therefrom.

Claim 2 was rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over *Morris et al.* in view of *Johnston, Jr. et al.* (U.S. Patent No. 5,598,524) and *Belfiore et al.* (U.S. Patent No. 5,611,060). For the reasons set forth below, Applicant traverses this rejection.

Claim 2 is directed to an aspect of dragging of the file icon. Namely, if the drag operation is performed at a speed equal to or greater than a predetermined speed, the reduced-size image is fixed at a current position while a drag operation is performed. If the drag operation is below the predetermined speed, a frame having the size of the reduced-size image is displayed. The office action acknowledges that *Morris et al.* is deficient in this regard, but contends that *Johnston, Jr. et al.* and *Belfiore et al.* remedy this deficiency. However, neither of these references teach or suggest how to treat a reduced-size image when its corresponding file icon is dragged at particular speeds.

Johnston, Jr. et al. describes that a shape such as a rectangle may be used to represent a dragged object. However, *Johnston, Jr. et al.* does not relate this operation to the speed of dragging in any way, nor does *Johnston, Jr.* disclose how the appearance of a reduced-size image should vary when a corresponding file icon is dragged.

Belfiore et al. describes that an auto-scrolling operation may be made to depend on the speed of a mouse indicator during a drag-and-drop operation. Here again, *Belfiore et al.* does not disclose or even suggest how the appearance of one object should change based on the dragging speed of some other object such as a file icon.

For at least these reasons, the proposed combination of *Morris et al.*, *Johnston, Jr. et al.* and *Belfiore et al.* would not have rendered claim 2 obvious.

Claims 5-7 and 11 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over *Morris et al.* in view of *Hirose* (U.S. Patent No. 5,745,112). For the reasons set forth below, Applicant traverses this rejection.

Claims 5-7 and 11 are directed to the concept of an icon return space. The illustrative example embodiments of the subject patent application describe that when a file icon is dropped in an icon return space, the file icon is moved back to its original display position without moving the associated reduced-size image. *See, e.g.*, page 9, line 25 to page 10, line 5. The

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office alleges that the dotted line in Figure 7 of Hirose *et al.* illustrate an icon return space. However, even assuming for the sake of argument that region 311 is argued to correspond to an icon return space, there is no disclosure of displaying such a space based on the distance of the file icon from a corresponding reduced-size image. For at least these reasons, the proposed combination of Morris *et al.* and Hirose would not have rendered the subject matter of claims 5-7 and 11 obvious.

Claim 8 was rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Morris *et al.* in view of Hirose, and further in view of Aparicio, IV *et al.* (U.S. Patent No. 5,727,174). For the reasons set forth below, Applicant traverses this rejection.

Claim 8 specifies that the icon return space is larger in size than the file icon. This is shown and described in the illustrative example embodiments with reference to Figure 3(b) and its related description beginning at page 10, line 20. The office action alleges that the frame around the mini-desk 49 in Figure 6 of Aparicio, IV *et al.* is an icon return area that is larger in size than the file icon (human figure 47) to be returned thereto.

Claim 8 depends from claim 5 and Aparicio, IV *et al.* does not cure the deficiency of Hirose with respect to, among other things, displaying an icon return space based on the distance of a file icon from a corresponding reduced-size image. In addition, human assistant 47 is not a file icon associated with a reduced-size image of a data file. For at least these reasons, the proposed combination of Morris *et al.*, Hirose and Aparicio, IV *et al.* would not have rendered claim 8 obvious.

Claims 9, 13, 14 and 20-25 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Morris *et al.* and Johnston *et al.* Claims 13, 24 and 25 have been amended along the same lines as claim 1 (from which claim 9 depends) and thus Morris *et al.* is deficient with respect to these claims for the reasons previously stated. Johnston *et al.* does not remedy these deficiencies and thus claims 9, 13, 14 and 20-25 are not rendered obvious by the proposed combination.

Claim 15 was rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over the proposed Morris *et al.*-Johnston *et al.* combination, in further view of Fleming (U.S. Patent No. 5,392,389). At least because Fleming does not remedy the deficiencies of the proposed Morris *et al.*-Johnston *et al.* combination with respect to claim 13 (from which claim 15

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depends), Applicant respectfully submits that claim 15 is not rendered obvious as alleged in the office action.

Claims 16 and 17 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over the proposed Morris *et al.*-Johnston *et al.* combination, in further view of Hirose. At least because Hirose does not remedy the deficiencies of the proposed Morris *et al.*-Johnston *et al.* combination with respect to claim 13 (from which claims 16 and 17 each depends) and because of the deficiencies of Hirose noted above, Applicant respectfully submits that claims 16 and 17 are not rendered obvious as alleged in the office action.

Claim 18 was rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over the proposed Morris *et al.*-Johnston *et al.*-Hirose combination, in further view of Aparicio, IV *et al.* At least because Aparicio, IV *et al.* does not remedy the deficiencies of the proposed Morris *et al.*-Johnston *et al.*-Hirose combination with respect to claim 16 (from which claim 18 depends) and because of the deficiencies of Aparicio, IV *et al.* noted above, Applicant respectfully submits that claim 18 is not rendered obvious as alleged in the office action.

Claim 19 was rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over the proposed Morris *et al.*-Johnston *et al.* combination, in further view of Belfiore *et al.* At least because Belfiore *et al.* does not remedy the deficiencies of the proposed Morris *et al.*-Johnston *et al.*-Hirose combination with respect to claim 13 (from which claim 19 depends) and because of the deficiencies of Belfiore *et al.* noted above, Applicant respectfully submits that claim 19 is not rendered obvious as alleged in the office action.

The amendments to the claims are believed to place this application in condition for allowance. Accordingly, entry of the amendments is believed to be appropriate and is respectfully requested.

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For at least the reasons set forth above, the pending claims are believed to be allowable and favorable office action is respectfully requested.

Respectfully submitted,

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